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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91184197
Party	Plaintiff United Parcel Service of America, Inc.
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	06/23/2009
Attachments	Motion to Amend NOO.pdf (7 pages)(20476 bytes) Exhibit 1.pdf (1 page)(5948 bytes) Amended NOO.pdf (10 pages)(34441 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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UNITED PARCEL SERVICE OF AMERICA, INC.,	:	
Opposer,	:	
v.	:	Opposition No. 91184197
POWERTECH INDUSTRIAL CO. LTD.,	:	
Applicant.	:	

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OPPOSER’S MOTION TO AMEND THE NOTICE OF OPPOSITION

Pursuant to Section 2.107(a) of the Trademark Rules of Practice and Rule 15(a) of the Federal Rules of Civil Procedure, Opposer United Parcel Service of America, Inc. (“Opposer”) respectfully submits Motion to Amend the Notice of Opposition (“Opposition”). Opposer respectfully requests that the Trademark Trial and Appeal Board (the “Board”) grant Opposer leave to amend the Notice of Opposition to include descriptiveness as a recently-discovered basis for this opposition. The proposed Amended Notice of Opposition is attached hereto as Exhibit 1.

INTRODUCTION

Opposer hereby moves to amend the Notice of Opposition herein to include descriptiveness as a basis for this opposition. It is axiomatic that Rule 15(a) requires that leave be “freely given” to amend pleadings. Courts routinely permit a plaintiff to amend its pleadings when the facts indicate that an amendment is necessary to conform the pleadings to the evidence and ensure that a plaintiff is provided with complete relief.

Opposer first received evidence that the designation HYBRID GREEN UPS is descriptive of Applicant’s goods on April 20, 2009. At that time, however, discovery was

already closed. Opposer therefore, after a reasonable period of time to research and determine a proper course of action in view of such evidence, seeks leave to amend its Notice of Opposition. Specifically, Opposer has added paragraphs 15 - 17 to its Notice of Opposition (Exhibit 1) to factually assert the new descriptiveness grounds pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C § 1052(e)(1).

In the present proceeding, Opposer respectfully submits that there is no prejudice to Applicant in allowing the proposed amendment to the Notice of Opposition. The application at issue is an intent-to-use application. Applicant is therefore not prejudiced by the fact that discovery is closed; Applicant could not conduct discovery to show acquired distinctiveness to rebut the addition of descriptiveness as a basis for this opposition. Moreover, Applicant's testimony period has not yet opened, so Applicant has that entire period to develop testimony to offer evidence from which Applicant may contend that the designation HYBRID GREEN UPS is not descriptive.

Accordingly, Opposer respectfully submits that justice is best served by that the Board's granting leave to amend the Notice of Opposition in the manner requested to ensure that the pleadings conform to the evidence.

STATEMENT OF FACTS

Opposer filed this opposition to the registration of U.S. Serial No. 77/176,134 for the designation HYBRID GREEN UPS on May 19, 2008, on the basis of deceptiveness, false suggestion of a connection, dilution, and likelihood of confusion. Opposer pled several of its federal registrations featuring the famous UPS mark.

In the course of discovery, counsel for the parties agreed to accept service of discovery materials by e-mail as if served by U.S. Mail. On January 26, 2009, Opposer served

interrogatories, requests for admission, and document requests on Applicant's counsel by e-mail.¹ Pursuant to the Trademark Rules of Practice, Applicant's responses to these discovery requests were due on March 2, 2009.

Opposer did not receive responses to its discovery requests by the March 2 date. Accordingly, Opposer's counsel contacted Applicant's counsel on March 5, 2009, and discovered that Applicant's counsel apparently had not received Opposer's electronically served discovery requests. Opposer therefore agreed to provide duplicate copies of Opposer's discovery requests and to allow Applicant additional time to respond. The parties cooperated to reset the testimony periods to facilitate this post-discovery period activity. In accordance therewith, Applicant served its responses to Opposer's discovery requests on April 16, 2009, and Opposer received those responses on April 20, 2009. Applicant's discovery responses are particularly important because the application at issue was filed on an intent-to-use basis, so Applicant's responses are an invaluable source of information about the HYBRID GREEN UPS designation and its intended use. Outside of these responses, Opposer has access to only limited information regarding these topics.

After thoughtfully analyzing Applicant's responses, Opposer determined that those responses provided new information that support an additional, alternative basis for opposition. Specifically, Applicant's HYBRID GREEN UPS designation is descriptive because "UPS" is disclaimed as descriptive and "HYBRID" and "GREEN" describe features and qualities of the goods to be offered in connection with Applicant's designation. Opposer required a reasonable period of additional time to evaluate this newly-discovered basis for opposition and consider its impact on this opposition proceeding. After taking a reasonable period of time to do exactly that,

¹ Discovery in this proceeding closed on the preceding Saturday, January 24, 2009, although as indicated, the parties cooperated to address the responses to Opposer's discovery requests.

Opposer has determined that it is appropriate to pursue this additional basis for opposition and seeks leave to amend its Notice of Opposition accordingly.

ARGUMENT

I. The Applicable Legal Standard

Rule 15(a) provides that a party may amend its pleadings by leave of court and that leave “shall be freely given when justice so requires.” Fed. R. Civ. P. 15(a). The United States Supreme Court has held that “this mandate is to be heeded.” Foman v. Davis, 371 U.S. 178, 182 (1962). In accordance with Rule 15(a)’s liberal mandate, it is well settled that “the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties.” Boral Ltd. v. FMC Corp., 59 U.S.P.Q.2d 1701, 1702 (T.T.A.B. 2000) (granting opposer leave to amend notice of opposition to add additional claim despite the fact motion to amend was filed two years after opposer filed the original notice of opposition).

Opposer seeks to amend the Notice of Opposition to include, as a basis for opposition, the descriptiveness of the designation HYBRID GREEN UPS. This basis arises from information that was uncovered through discovery, but not until well after discovery closed. Opposer received this information barely two months ago, and since that time, has studied and considered the viability of this new basis for opposition and its implications for Opposer’s conduct of this opposition. Unlike the circumstances in Boral, this request for leave to amend comes a little over one year after the Notice of Opposition was filed and well before it could cause any legally cognizable prejudice to Applicant.

The Board should grant Opposer leave to add this recently-discovered basis since Board decisions favor a liberal application of Rule 15 to permit an Opposer to amend its pleadings. See, e.g., Space Base, Inc. v. Stadis Corp., 17 U.S.P.Q.2d 1216, 1217 n.1 (T.T.A.B. 1990)

(granting leave to amend notice of opposition during testimony period of proceeding to add claim of ownership of newly issued registration).

In Space Base, the Board, while acknowledging Opposer's delay in amending the notice of opposition, nonetheless granted leave to amend on the basis that any prejudice suffered by Applicant caused by the delay would be far outweighed by the principle that "the interests of justice and judicial economy would be best served by permitting all claims . . . to be adjudicated in one proceeding." Id. Thus, even if Applicant were able to show some prejudice caused by any alleged delay, the Board should still allow Opposer to amend the Notice of Opposition because the interest of justice in having a full adjudication of the merits outweighs any prejudice the Applicant may claim.

II. Opposer Should be Allowed to Amend Its Notice of Opposition Because It Did Not Delay and Applicant Will Not be Prejudiced by Allowing the Amendment

Until Opposer received Applicant's responses to its discovery requests on April 20, 2009, amending the Notice of Opposition to include descriptiveness as a basis was neither possible nor necessary. At that point, discovery was long closed. Opposer then reviewed the responses and discovered information that led to an additional, alternative basis for this opposition. With this information in hand, Opposer took a reasonable period of time to analyze this information and consider its legal implications. Therefore, Opposer did not delay in filing this amendment.

Applicant cannot demonstrate that allowing the proposed amendment at this time would cause it any prejudice. Applicant has not yet used the designation HYBRID GREEN UPS, so there is no discovery to be taken with regard to secondary meaning. Applicant's testimony period has not yet opened, so Applicant is free to develop testimony that its HYBRID GREEN UPS mark is not descriptive. By contrast, the facts indicate that an amendment is necessary to conform the pleadings to the evidence. Therefore, Opposer respectfully submits that the Board

should grant Opposer leave to amend the Notice of Opposition to include the proposed amendment, allow Applicant sufficient time to answer the Amended Notice of Opposition, and reset the testimony periods to facilitate the introduction of testimony directed to this recently acquired evidence.

CONCLUSION

For the foregoing reasons, Opposer respectfully requests that the Board grant its motion to amend the Notice of Opposition and such other and further relief as the Board deems just and proper.

Dated: June 23, 2009

Respectfully submitted,

/Stephen M. Schaetzel/

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Attorneys for Opposer
UNITED PARCEL SERVICE OF
AMERICA, INC.

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing Opposer's Motion to Amend the Notice of Opposition was served this day via electronic mail, pursuant to agreement, addressed to:

Morton J. Rosenberg
ROSENBERG, KLEIN AND LEE
rkl@rkllpatlaw.com

This 23rd day of June, 2009.

/Stephen M. Schaetzel/
Stephen M. Schaetzel

EXHIBIT 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application
Serial No. 77/176,134 Published
in the Official Gazette of
March 18, 2008, at Page TM 603

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UNITED PARCEL SERVICE OF AMERICA, INC., :

Opposer, : Opposition No. 91184197

v. :

POWERTECH INDUSTRIAL CO., LTD., :

Applicant. :

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AMENDED NOTICE OF OPPOSITION

TO THE COMMISSIONER OF TRADEMARKS:

UNITED PARCEL SERVICE OF AMERICA, INC. ("UPS" or "Opposer"), a Delaware corporation located and doing business at 55 Glenlake Parkway, N.E., Atlanta, Georgia 30328, believes that it will be damaged by the registration of Application Serial No. 77/176,134 for the designation HYBRID GREEN UPS as a trademark filed on May 9, 2007, by Powertech Industrial Co., Ltd. ("Applicant"), and hereby opposes the same ("Opposition").

The grounds for Opposition are as follows:

1. Opposer is the world's largest package delivery company providing air and ground transportation and delivery services for packages, documents, and other personal property throughout the United States and the world. Opposer, in connection with its business, provides electronic components and equipment, including computer hardware and software.

2. Since at least as early as 1933, long prior to the filing date of the intent-to-use application herein opposed, Opposer has adopted, used, and continued to use the mark UPS in interstate commerce in connection with, *inter alia*, transportation and delivery services. In addition, long prior to the filing date of the intent-to-use application herein opposed, Opposer has used the mark UPS in interstate commerce in connection with electronic components and equipment, including computer hardware and software. Since the date of first use of the mark UPS, Opposer has continuously used that mark to identify and distinguish Opposer's goods and services from those of others.

3. Opposer's marks comprising or incorporating the mark UPS are now and ever since their dates of first use have been used in connection with Opposer's goods and services and applied to product literature and other materials in connection with those goods and services. The goods and services offered for sale and sold under the mark UPS have been extensively advertised and promoted. As a result of the quality of Opposer's goods and services, the advertising for such goods and services, and Opposer's reputation for fair dealing with the trade and the public, the mark UPS has become famous with goodwill of inestimable value to Opposer, and the famous mark UPS identifies and distinguishes Opposer's goods and services from those of others to the trade and to the public.

4. Opposer is the owner of a number of registrations for marks comprising or incorporating "UPS" on the Principal Register of the United States Patent and Trademark Office, including without limitation:

<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS AND SERVICES</u>
UPS and Design	514,285	Aug. 23, 1949	Motor vehicle delivery service for retail stores
UPS	966,774	Aug. 21, 1973	Transportation of personal property for hire by diverse modes of transportation
UPS 2 nd DAY AIR and Design	1,277,400	May 8, 1984	Motor Vehicle and Air Transportation of Personal Property
UPS NEXT DAY AIR and Design	1,375,109	Dec. 10, 1985	Motor Vehicle and Air Transportation of Personal Property
UPS AIR CARGO SERVICE	1,460,348	Oct. 6, 1987	Motor Vehicle and Air Transportation of Personal Property
UPS PREFERRED	1,874,248	Jan. 17, 1995	Transportation by air, rail, boat, and motor vehicle of packages and freight
UPS PREFERRED and Design	1,876,943	Jan. 31, 1995	Transportation by air, rail, boat, and motor vehicle of packages and freight
UPS NEXT DAY AIR	1,878,016	Feb. 7, 1995	Motor vehicle and air transportation of personal property
UPS 2 nd DAY AIR	1,878,918	Feb. 14, 1995	Motor vehicle and air transportation of personal property
UPS TRACKPAD	2,098,168	Sept. 16, 1997	Computer programs and hand-held computers used for collection of package transit and delivery information
UPS ONLINE	2,128,739	Jan 13, 1998	Software for use in preparing and printing shipping documents and invoices and tracking the shipped packages
UPS and Design	2,278,090	Sept. 14, 1999	Software for use in preparing and printing shipping documents and invoices and tracking the shipped packages
UPS ONLINE ENVOY	2,582,489	June 18, 2002	Software for use in preparing and printing shipping documents and invoices, and tracking of the shipped packages;

			<p>Telecommunication services, namely, providing information on international transportation and delivery services and package tracking using a global computer network;</p> <p>Delivery of personal property by air, rail, boat and motor vehicle</p>
UPS INTERNET TOOLS	2,830,249	April 6, 2004	<p>Software for use in preparing and printing shipping forms, documents and invoices, and tracking of the shipped packages;</p> <p>Delivery of personal property by air, rail, boat and motor vehicle; providing computerized information on domestic and international transportation and delivery services and package tracking</p>
UPS.COM	2,483,193	Aug. 28, 2001	<p>Computer software for use in connection with worldwide pick up, tracing, and delivery of personal property by air, rail, boat, and motor vehicles</p>
UPS WORLDSHIP	3,160,062	Oct. 17, 2006	<p>Computer hardware, operating software and peripherals, modems, laser and thermal printers, scanners, network interface cards, electrical and fiber optic cables, scales and display screens, for package shipping rate calculators, shipping record keeping and software for use in preparing and printing shipping documents and invoices, and tracking of shipped packages;</p> <p>Computerized tracking and tracing of packages in transit, namely, providing computerized information on domestic and international transportation and delivery services;</p> <p>Transportation and delivery of personal property by air, rail, boat and motor vehicle</p>
UPS	2,520,558	Dec. 18, 2001	<p>Software for use in preparing and printing</p>

			shipping documents and invoices and tracking the shipped packages
UPS and Design	2,973,108	July 19, 2005	<p>Computer hardware and computer software in the field of transportation and delivery and in connection with worldwide pick-up, tracing and delivery; batteries; alternative power supply appliances, namely, voltage surge protectors; magnetic discs and tapes; computer printers, scales and scanners; computer software for providing automated download of files, for preparing and printing of shipping labels, documents and invoices, for providing electronic shipping labels, shipping documents and invoices, for providing information on available transportation and delivery services, and for providing proof of delivery documentation, including digitized signature of the recipient of the package and the receipt, transmission and processing of customer identifying shipping account information;</p> <p>Printed materials pertaining to information transportation and delivery, namely, press releases, pamphlets, brochures, newsletters, books, posters, periodicals, calendars, magazines, printed instructional, educational and teaching material, paper banners, envelopes, cardboard boxes and packages, shipping and address labels, stationery, desk sets, pen and pencil sets, pen, paper clip dispensers, pen and holder desk sets, note holders, fountain pens, desk folders, stationery-type portfolios, business card files, ring binders, letter openers, desk caddies, packing paper, paper bags, cardboard, cardboard envelopes and cartons; plastic bags and envelopes and pouches for packaging, plastic bubble packs for wrapping or packaging;</p> <p>Clothing, namely, hats, shorts, sweaters,</p>

			<p>jackets, socks, coats, t-shirts, pants, shirts, vests, sweatshirts, rainwear, footwear and gloves;</p> <p>Advertising services; logistics management in the field of transportation and delivery; business management services; business consulting services; business administration services;</p> <p>Providing facilities for the use of office equipment and machinery; management assistance services in the field of transportation and delivery; management consulting services; providing computerized tracking and tracing of packages in transit; distribution of advertising samples for others; mail sorting handling and receiving services; retail store services featuring stamps and office supplies; data processing services; photocopying services; document reproduction services; Franchising, namely, offering technical assistance in the establishment and/or operation of retail mailing, shipping, packaging, faxing and electronic communication outlets; providing automated registration for customer identifying shipping account information over the global computer network; licensing of computer software; transportation network management solution services; arranging expedited pick-up, storage, transportation and delivery services; customs clearance services;</p> <p>Communications services and telecommunications services, namely, electronic transmission of messages, data and voice data; facsimile and electronic message services, message delivery and sending services, telephone services and wire services; services of transportation of letters, documents and other texts by telex, by telephone, by electronic means;</p>
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			<p>online document delivery via a global computer network;</p> <p>Legal services; scientific research services; design and development of computer hardware and software; consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others</p>
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The aforementioned marks ("Opposer's Marks") have been used in commerce prior to the filing date of the intent-to-use application herein opposed. The registrations for each of these marks are valid and subsisting, unrevoked and uncanceled, and in full force and effect. Registrations Nos. 514,285; 2,520,558; 2,483,193; 2,582,489; 2,278,090; 2,128,739; 2,098,168; 1,878,918; 1,878,016; 1,876,943; 1,874,248; 1,460,348; 1,375,109; 1,277,400; 966,774; and 514,285 are incontestable under 15 U.S.C. § 1065.

5. As a result of their long, widespread, and extensive use by Opposer, Opposer's Marks are of great value to Opposer. Opposer's Marks identify and distinguish Opposer's goods and services from the goods and services of others, symbolize the goodwill of Opposer's business, and are famous in the United States.

6. As a result of the long, widespread and extensive use by Opposer, Opposer's Marks have been well-known to consumers generally, enjoy widespread recognition, and are famous and strong marks entitled to the broadest scope of protection.

7. Upon information and belief, no party other than Opposer owns or is using any federally registered mark that is the same as or is substantially similar to Opposer's Marks for the same or substantially similar services.

8. By the intent-to-use application herein opposed, Applicant seeks to register the designation HYBRID GREEN UPS as a trademark for “power supplies; mobile phone battery chargers; mobile phone battery charger stations; battery chargers; universal power supplies; power saving adapters; electric storage batteries; uninterruptible power supplies; AC/DC converters; power source stable adapters” in International Class 9.

9. Upon information and belief, Applicant is unable to establish priority of use or priority of rights in the United States in connection with Applicant's designation HYBRID GREEN UPS.

10. Applicant's goods intended to be offered under its designation HYBRID GREEN UPS are the same or similar to the goods and services in connection with which Opposer has long used and continues to use Opposer's Marks.

11. The goods covered by the application for registration of Applicant's designation HYBRID GREEN UPS will be encountered by the same or similar class of purchasers as those who are interested in or familiar with the goods and services promoted, offered, and provided by Opposer under the well-known Opposer's Marks.

12. Applicant's designation HYBRID GREEN UPS so closely resembles Opposer's Marks as to be likely, when used in connection with Applicant's proposed goods, to cause confusion, to cause mistake, and to deceive with consequent injury to Opposer and the public.

13. Applicant's designation HYBRID GREEN UPS so closely resembles Opposer's Marks that potential purchasers of the goods intended to be offered under Applicant's proposed mark would be likely to believe that Opposer is the source of such goods, or that Opposer has authorized, sponsored, approved of, or in some other manner associated itself with the goods of

Applicant, thereby creating a likelihood of confusion, deception or mistake, all to the damage of Opposer.

14. Applicant's designation HYBRID GREEN UPS falsely suggests a connection or affiliation between Opposer and Applicant are therefore is not entitled to registration.

15. Applicant has disclaimed the "UPS" portion of the designation HYBRID GREEN UPS and descriptive of the goods intended to be offered in connection with the mark.

16. Applicant intends to offer goods in connection with the designation HYBRID GREEN UPS that are energy efficient and operate on multiple energy sources.

17. Applicant's designation HYBRID GREEN UPS describes a quality and feature of the proposed goods and therefore is merely descriptive pursuant to 15 U.S.C. § 1052(e)(1).

18. Opposer's UPS mark is famous within the meaning of Section 43(c) of the Lanham Act, and the use by Applicant of the designation HYBRID GREEN UPS for Applicant's goods would cause dilution of the distinctive quality of Opposer's UPS mark.

19. Opposer has used the UPS mark in commerce for years in connection with electronic components and equipment, including computer hardware and software. Opposer's UPS mark has since become famous, with strong and distinctive character qualifying for protection under Sections 13 and 43(c) of the Lanham Act, as amended.

20. Application Serial No. 77/176,134 was filed on May 9, 2007, and therefore is subject to the provisions of Sections 13 and 43(c) of the Lanham Act, as amended.

21. Applicant's use and registration of the designation HYBRID GREEN UPS as shown in Application Serial No. 77/176,134 will lessen the capacity of Opposer's famous and distinctive UPS mark to distinguish Opposer's goods and services from those of others, all to the damage of Opposer.

22. Opposer will be damaged by the registration sought by Applicant because such registration would constitute *prima facie* evidence of Applicant's exclusive right to use Applicant's designation for and in connection with Applicant's goods, which would be inconsistent with and detrimental to Opposer's prior, established, and superior rights in the UPS mark.

WHEREFORE, Opposer requests that its Opposition to Application Serial No. 77/176,134 for registration of HYBRID GREEN UPS be sustained and that the registration sought by applicant be refused.

Dated: June 23, 2009

By: /Stephen M. Schaetzel/

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